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REMARKS

In response to the Office Action dated March 23, 2007, the Assignee respectfully requests reconsideration based on the above claim amendments and on the following remarks. The Assignee respectfully submits that the pending claims already distinguish over the cited documents to *Goodman, Hylton, Rajakarunanayake, D'Luna,* and *Lorenz.*

Claims 1-16 are currently pending in this application. These claims were rejected over various combinations of *Goodman, Hylton, Rajakarunanayake, D'Luna,* and *Lorenz.*

The Assignee shows, however, that the pending claims cannot be obvious over these documents. The pending claims already recite, or incorporate, features that are not taught or suggested by *Goodman, Hylton, Rajakarunanayake, D'Luna,* and *Lorenz,* whether considered alone or in any combination. Moreover, *Goodman's* principle of operation must be impermissibly changed to support the *prima facie* cases, so *Goodman* "teaches away" and cannot support the Examiner's *prima facie* cases for obviousness. Because *Goodman's* principle of operation must be impermissibly changed to support the *prima facie* cases, one of ordinary skill in the art would not expect success when making the modifications suggested by the Examiner.

The Assignee thus respectively submits that the pending claims distinguish over the cited documents and are ready for allowance.

Rejection of Claims 1-4, 11-12 & 14-15

The Office rejected claims 1-4, 11-12, and 14-15 under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent 5,666,486 to Goodman, *et al.* in view of U.S. Patent 5,708,961 to Hylton *et al.* If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires "some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill"; 2) there must be a reasonable expectation of success; and 3) all the claimed

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limitations must be taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter "M.P.E.P.").

Claims 1-4, 11-12, and 14-15, however, cannot be obvious over the cited documents. These claims recite, or incorporate, features that are not taught or suggested by the proposed combination of *Goodman* and *Hylton*. Independent claim 1, for example, recites "*a media server tuning to a transport layer and transmitting the entire transport layer, rather than a single program stream, over a system bus*" (emphasis added). Independent claim 12 recites similar features. As the following paragraphs explain, the combined teaching of *Goodman* and *Hylton* completely fails to teach or suggest at least these features. Examiner Shepard cites various passages of *Goodman*, yet the Assignee shows that *Goodman* is silent to these features.

Examiner Shepard, for example, cites to *Goodman* at FIG. 9, element 903. Examiner Shepard, however, is, very respectfully, mistaken. When *Goodman* explains FIG. 9, *Goodman* explains that the "tuner 901 selects a specific 6 MHz channel from the input spectrum and presents it ... to the digital communications section 903." U.S. Patent 5,666,486 to Goodman, *et al.* (Sep. 9, 1997) at column 19, lines 26-28 (emphasis added). Because *Goodman's* tuner selects a specific channel from the input spectrum, *Goodman* cannot "*tun[e] to a transport layer and [transmit] the entire transport layer, rather than a single program stream, over a system bus*," as is recited by independent claims 1 and 12.

Examiner Shepard also cites to other passages of *Goodman*. Examiner Shepard, for example, points to *Goodman* at column 15, lines 1-7 and at column 13, lines 42-46. Examiner Shepard, however, is again, very respectfully, mistaken. These passages do not teach or suggest "*a media server tuning to a transport layer and transmitting the entire transport layer, rather than a single program stream, over a system bus.*" These passages, instead, describe how the MPEG II standard requires a program association table. *See* U.S. Patent 5,666,486 to Goodman, *et al.* (Sep. 9, 1997) at column 14, line 63 through column 15, line 1. *Goodman* explains how an ATM network "puts all the MPEG encoded data into one unidirectional optical connection ... to an ATM demultiplexer ... 604." *Id.* at column 13, lines 60-65. The MPEG data "then goes

down a stream toward the NIM [Network Interface Module] 201." *Id.* at column 14, lines 1-2. The MPEG data is mapped to unique program numbers within the stream. *See id.* at column 14, lines 15-19. The NIM 201 "uses the program numbers to separate the MPEG packets and hand the video to an MPEG decoder." *Goodman* then begins a discussion of FIG. 7. So, the only reasonable conclusion is that these passages explain how MPEG data is mapped and separated into individual programs. Because the MPEG data is mapped and separated into individual programs, *Goodman* cannot "*tun[e] to a transport layer and [transmit] the entire transport layer, rather than a single program stream, over a system bus,*" as is recited by independent claims 1 and 12.

Moreover, other passages of *Goodman* support the Assignee's position. FIG. 8 of *Goodman* describes a digital entertainment terminal having MPEG demultiplexer circuitry. *See* U.S. Patent 5,666,486 to Goodman, *et al.* (Sep. 9, 1997) at column 16, lines 12-14. *Goodman* explains how this MPEG demultiplexer circuitry "*recognizes audio and video packets of a selected program* in the MPEG data stream and routes those packets to the decoders." *Id.* at column 16, lines 57-60. Because the MPEG demultiplexer recognizes packets for a selected program, *Goodman* cannot "*tun[e] to a transport layer and [transmit] the entire transport layer, rather than a single program stream, over a system bus,*" as is recited by independent claims 1 and 12.

The patent to Hylton, *et al.* also fails to teach or suggest at least these features. *Hylton* explains how multiple channels are received from a network, and a channel selector chooses a channel. U.S. Patent 5,708,961 to Hylton *et al.* (Jan. 13, 1998) at column 5, lines 41-47. *See id.* at column 5, lines 64-66. A program selector then selects an individual program from the selected channel. *See id.* at column 5, line 67 through column 6, line 2. The selected program is then supplied to a multiplexer. *See id.* at column 6, lines 2-5. *Hylton*, then, cannot "*tun[e] to a transport layer and [transmit] the entire transport layer, rather than a single program stream, over a system bus,*" as is recited by independent claims 1 and 12.

Moreover, independent claim 12 recites many other distinguishing features. Claim 12, for example, recites "a tuner array <u>connected to a system bus</u>" and "a broadband input/output module <u>connected to the system bus and</u> receiving the transport layer from the system bus and sending the transport layer to a network bus" (emphasis added). Support for such features may be found at least in FIG. 7 of the as-filed application. Independent claim 12 also recites "a network input/output module <u>connected to the network bus and</u> retrieving the transport layer from the network bus" and "a decryption module <u>connected to the network input/output module and</u> that receives the transport layer from the network input/output module and that decrypts the transport layer" (emphasis added). Support for such features may be found at least in FIG. 7 of the as-filed application. Independent claim 12 also recites "*a demultiplexer <u>connected to the decryption module and</u> that receives the decrypted transport layer and that demultiplexes the transport layer*" and "*another decoder <u>connected to the demultiplexer</u> that decodes the demultiplexed and decrypted transport layer*" (emphasis added). Support for such features may be found at least in FIG. 7 of the as-filed application. The proposed combination of *Goodman* and *Hylton* fails to teach or suggest this physical orientation, so *Goodman* and *Hylton* cannot obviate independent claim 12.

Claims 1-4, 11-12, and 14-15, then, cannot be obvious. These claims recite, or incorporate, many features that are not taught or suggested by the proposed combination of *Goodman* and *Hylton*. The combined teaching of *Goodman* and *Hylton*, for example, is at least silent to "*a media server tuning to a transport layer and <u>transmitting the entire transport layer, rather than a single program stream,</u> over a system bus*" (emphasis added). Moreover, independent claim 12 recites many other distinguishing features. One of ordinary skill in the art, then, would not think that independent claims 1 and 12 are obvious over *Goodman* and *Hylton*. Their respective dependent claims incorporate the same distinguishing features and recite additional features. Claims 1-4, 11-12, and 14-15, then, cannot be obvious. The *prima facie* case for obviousness must fail, so Examiner Shepard is respectfully requested to remove § 103 (a) rejection.

Goodman "Teaches Away"

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Any proposed combination involving *Goodman* "teaches away" from the pending claims. "A reference that 'teaches away' from the claimed invention is a significant factor" when determining obviousness. *See* M.P.E.P. at § 2145 (X)(D)(1). A reference must be considered as a whole, including portions that lead away from the claimed invention. *See id.* at § 2141.02. "It is improper to combine references where the references teach away from their combination." M.P.E.P. at § 2145 (X)(D)(2). If the proposed combination changes the principle of operation of the prior art being modified, then the teachings of the references are not sufficient to support a *prima facie* case. *See* M.P.E.P. at § 2143.01.

The Examiner's *prima facie* cases all require impermissible changes to *Goodman's* principle of operation. As the above paragraphs explained, *Goodman* explains that the "tuner 901 selects a specific 6 MHz channel from the input spectrum and presents it ... to the digital communications section 903." U.S. Patent 5,666,486 to Goodman, *et al.* (Sep. 9, 1997) at column 19, lines 26-28 (emphasis added). *Goodman's* MPEG demultiplexer circuitry "recognizes audio and video packets of a selected program in the MPEG data stream and routes those packets to the decoders." *Id.* at column 16, lines 57-60. *Goodman's* principle of operation, then, must be changed to support a rejection of "*a media server tuning to a transport layer and transmitting the entire transport layer, rather than a single program stream, over a system bus*" (emphasis added). Because, however, the patent laws prohibit changing a principle of operation to support a *prima facie* case, *Goodman* cannot be used to reject the claims. Examiner Shepard is respectfully requested to remove all the § 103 (a) rejections that are based on any combination of *Goodman*.

Rejection of Claims 5-9 & 16

The Office rejected claims 5-9 and 16 under 35 U.S.C. § 103 (a) as being unpatentable over *Goodman* in view of *Hylton* and further in view of U.S. Patent 6,810,413 to Rajakarunanayake, *et al.* *Rajakarunanayake* discloses customer premise equipment having a wireless receiver. The combined teaching of *Goodman, Hylton,* and *Rajakarunanayake,*

however, still fails to teach or suggest all the features incorporated into claims 5-9 and 16. Claims 5-9, for example, depend from independent claim 1 and, thus, incorporate *"a media server tuning to a transport layer and transmitting the entire transport layer, rather than a single program stream, over a system bus"* (emphasis added). Dependent claim 16 incorporates similar features from independent claim 12, plus the many other distinguishing features recited in independent claim 12.   Because the combined teaching of *Goodman, Hylton,* and *Rajakarunanayake* fails to teach or suggest at least these features, one of ordinary skill in the art would not think that claims 5-9 and 16 are obvious. The *prima facie* case for obviousness must fail, so Examiner Shepard is respectfully requested to remove § 103 (a) rejection.

Rejection of Claim 10

The Office rejected claim 10 under 35 U.S.C. § 103 (a) as being unpatentable over *Goodman* in view of *Hylton* and further in view of U.S. Patent Application Publication 2002/0106018 to D'Luna *et al*. *D'Luna* discloses a single-chip set top box. The combined teaching of *Goodman, Hylton,* and *D'Luna,* however, still fails to teach or suggest all the features incorporated into claim 10. Because claim 10 depends from independent claim 1, claim 10 incorporates *"a media server tuning to a transport layer and transmitting the entire transport layer, rather than a single program stream, over a system bus"* (emphasis added). Because the combined teaching of *Goodman, Hylton,* and *D'Luna* fails to teach or suggest at least these features, one of ordinary skill in the art would not think that claim 10 is obvious. The *prima facie* case for obviousness must fail, so Examiner Shepard is respectfully requested to remove § 103 (a) rejection.

Rejection of Claim 13

The Office rejected claim 13 under 35 U.S.C. § 103 (a) as being unpatentable over *Goodman* in view of *Hylton* and further in view of U.S. Patent Application Publication 2004/0244056 to Lorenz, *et al*. *Lorenz* discloses a two-way communications channel between a customer's interactive television and a customer support center. The combined teaching of

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Goodman, *Hylton*, and *Lorenz*, however, still fails to teach or suggest all the features incorporated into claim 13. Because claim 13 depends from independent claim 12, claim 13 incorporates *"a tuner array receiving and demodulating a plurality of transport layers, tuning to a specific transport layer identified by a decoder and <u>sending the entire identified transport layer, rather than a single program stream, over a system bus</u>"* (emphasis added). Moreover, dependent claim 13 incorporates the many other distinguishing features recited in independent claim 12. Because the combined teaching of *Goodman*, *Hylton*, and *Lorenz* fails to teach or suggest at least these features, one of ordinary skill in the art would not think that claim 13 is obvious. The *prima facie* case for obviousness must fail, so Examiner Shepard is respectfully requested to remove § 103 (a) rejection.

No Reasonable Expectation of Success is Possible

The Examiner's *prima facie* cases for obviousness must include "a reasonable expectation of success." DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition). Here, however, the Examiner's *prima facie* cases can have no reasonable expectation of success. Because *Goodman's* principle of operation must be impermissibly changed to support the *prima facie* cases, one of ordinary skill in the art would not expect success when making the modifications suggested by the Examiner. Examiner Shepard is thus respectfully requested to remove all the § 103 (a) rejections that are based on any combination of *Goodman*.

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If any questions arise, the Office is requested to contact the undersigned at (919) 469-2629 or *scott@scottzimmerman.com*.
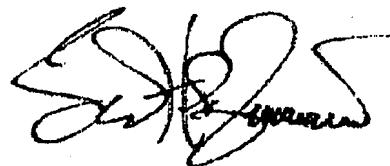
Respectfully submitted,

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